

Appl. No.: 10/701,085
Amdt. dated January 28, 2009
Reply to Office Action of June 28, 2008
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REMARKS

This Amendment is filed in response to the Office Action dated July 28, 2008.

Applicants first note with appreciation the Examiner's thorough examination of the application as evidenced by the Office Action. Applicants have amended claims 1-4 and 6-8 and added new claims 21-28. Claims 9-21 were previously withdrawn. Following these amendments, the application includes claims 1-8 and 21-28 with independent claims 1 and 21. Applicants respectfully submit that the claims are patentable. As such, Applicants respectfully request issuance of a Notice of Allowance in light of the remarks below.

I. The Claims Invention Is Patentable Subject Matter Under § 101

In paragraph 5, the Office Action rejects claims 1-8 under 35 U.S.C. § 101 as non-patentable subject matter. The Office Action alleges that the claims are not tied to a machine and only recite mental steps. Further, the Office Action argues that the claims do not render a concrete, tangible, and useful outcome. Applicants respectfully disagree with this rejection.

Subsequent to issuance of the Office Action, the Federal Circuit issued *In re Bilski*, No 2007-1130, Oct. 30, 2008, which relates to the question of patentable subject matter for method claims. In *Bilski*, the Court settled on the machine-or-transformation test, which states that a claimed process is patent-eligible if "(1) it is tied to a particular machine or apparatus, or (2) it transforms a particular article into a different state or a thing." Applicants respectfully submit that claims 1-8, as amended, meet both prongs of the machine-or-transformation test.

Claims 1-8 are tied to a particular apparatus. Independent claim 1 specifically recites a "method performed on an electronic content management system." Further, many of the claimed steps recite performing operations over an electronic network and storing data in an electronic database. Clearly, independent claim 1 and dependent claims 2-8 are tied to a particular apparatus (i.e., a content management system, electronic network, and an electronic database).

Further, the claimed invention of independent claim 1 transforms a particular article into a different state or a thing. As recited in independent claim 1, a feedback message received from

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a consumer that includes comments regarding published content is transformed by the method to an escalation feedback message where the escalation feedback message is based at least on the comments regarding published comments that are in the feedback message. There is thus a transformation of an article into a different thing in the claimed method.

In light of the above, although required to meet only one prong of the *Bilski* test, the claimed invention is both tied to a machine and performs a transformation of an article.

Applicants thus submit that claims 1-8 recite patentable subject matter in accordance with 35 U.S.C. § 101.

II. The Claims Are Patentable Over at least the Cited Prior Art

In paragraphs 6 and 7, the Office Action rejects claims 1, 4, and 6 under 35 U.S.C. § 102(b) as anticipated by website information from Island Data.¹ Further, in paragraphs 8-12, the Office Action rejected claims 2, 3, 5, 7, and 8 under 35 U.S.C. § 103 as obvious in light of Island Data in combination with respective different references. Applicants respectfully disagree with these rejections.

Regarding independent claim 1, at page 6, the Office Action states that no weight is given to the phrase “from a customer regarding published content.” The Office Action alleges that this recitation is a mere statement of use. The Office Action cites MPEP 7.37.09, stating:

a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior structure is capable of performing the intended use, then it meets the claim.

Applicants respectfully note that the Office Action’s refusal to give weight to the limitations of the claim is misplaced. MPEP 7.37.09 is not directed to method claims. Instead, the requirement for structural differences is limited to apparatus, article, and composition claims only. U.S. Patent law states that functional language in apparatus, article, or composition claims is not given weight unless there is a structural difference

¹ While the Office Action raises issues regarding priority date for the claims, Applicants do not address these statements herein, given that the claimed invention is clearly patentable over the cited prior art.

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provided in the claim for performing the recited function that is not found in the prior art. By definition, method claims are directed to steps having various step limitations. Structural limitations in a method claim are not required for recited limitations to be given weight. Indeed, U.S. Patent law nowhere requires that a method claim recite "structural difference between the claimed invention and the prior art in order to patentably distinguished the claimed invention from the prior art." Such a requirement would require the introduction of recited structure into method claims.²

In light of the above, weight must be given to recitations in the claim 1 that the feedback message includes comments regarding published content and that the generation of an escalation message is based on comments regarding published content located in the feedback message.

Furthermore, at least these recited limitations of claim 1 are not taught or suggested by the cited references. Nowhere does Island Data teach or suggest receiving feedback messages from customers containing comments on published content.³ Further, nowhere does Island Data teach or suggest generation of an escalation feedback message that is at least based on the comments regarding published content. At best, Island Data discloses a technical support system where technical support questions from customers are escalated if they cannot be answered by a simple canned solution. The claimed invention of claim 1 is somewhat different. The claimed invention is directed at receiving feedback from consumers regarding published content and providing these comments to a content management system to create a direct feedback loop between the content management system and consumers. One would be hard pressed to argue that a technical support system would teach or suggest creating such a feedback loop without use of impermissible hindsight.

² It is noted that even the controlling machine-or-transformation test recited in *Bilski* reflects this point. The test does not require that a method claim be tied to structure and transform an article. It is an or test.

³ It is noted by Applicants that the Office Action does not attempt to argue that Island Data teaches or suggests these recitations.

Applicants thus submit that independent claim 1 and dependent claims 2-8 are patentable. Applicants note that newly added independent claim 21 includes the same recited recitations. As such, independent claim 21 and dependent claims 22-28 are also patentable.

III. Dependant Claims 5 and 25 Recite Additional Patentable Matter

Notwithstanding the reasons stated above concerning the patentability of claim 1, claims 5 and 25 present independently patentable subject matter. Although the Office Action rejects claim 5 under 35 U.S.C. § 103(a) as being unpatentable over Island Data in view of Gardenswartz et al (U.S. Patent 6,055,573) in paragraphs 8 and 9, the claims include a step beyond anything taught or suggested in the prior art either individually or combined. In particular, the claimed monitoring system is activated by a consumer's express interest.

Claims 5 and 25 present embodiments of a system for monitoring that is not performed in the potentially random manner taught or suggested by the prior art. Instead, receiving a feedback message triggers the content monitoring feature of the claims. Specifically, the claims present a system where a consumer can mark him or herself as being interested in the available content through the feedback message system. This marking can then trigger the unique monitoring approach described in the claimed matter. This provides added benefit over conventional systems that monitor all users of a web site. Here, the claimed invention monitors users that have shown added interest by providing feedback and thus providing monitored data on a subset of consumers. The monitoring of this specific subset of consumers results in more accurate tracking data. Subsequently, this higher level data can be utilized to more effectively provide service to the consumer.

In light of the above, claims 5 and 25 possess qualities exceeding those taught in the prior art. Applicants thus submit that in addition to patentability under the arguments submitted in sections I and II above, claims 5 and 25 could be patentable individually.

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Conclusion

In view of the amended and added claims, and the remarks presented above, it is respectfully submitted that all of the present claims of the application are in condition for immediate allowance. It is therefore respectfully requested that a Notice of Allowance be issued. The Examiner is encouraged to contact Applicants' undersigned attorney to resolve any remaining issues in order to expedite examination of the present application.

It is not believed that extensions of time or fees for net addition of claims are required, beyond those that may otherwise be provided for in documents accompanying this paper. However, in the event that additional extensions of time are necessary to allow consideration of this paper, such extensions are hereby petitioned under 37 CFR § 1.136(a), and any fee required therefore (including fees for net addition of claims) is hereby authorized to be charged to Deposit Account No. 13-4365.

Respectfully submitted,



W. Kevin Ransom
Registration No. 45,031

Customer No. 24239

Moore & Van Allen PLLC
Post Office Box 13706
430 Davis Drive, Suite 500
Research Triangle Park, North Carolina 27709
Phone: (704) 331-3549
Fax: (704) 339-5918

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